

REMARKS

The Office Action dated July 28, 2003 has been reviewed. Applicant thanks the Examiner for allowing claims 3-4 and 13-18. Claim 1 have been amended. Claims 1-19 are pending, of which claims 1-2, 5-12 and 19 are respectfully submitted for reconsideration by the Examiner.

Claims 1, 2, 5-9 and 19 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,399,836 to de Versterre et al. ("de Versterre"). Claims 10-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over de Versterre. These rejections are traversed. Claim 1 has been amended to alternatively recite subject matter of Applicant's invention. Amended claim 1 recites an air mass flow controller valve for fuel cells including at least two actuators and at least two closure members. One actuator is coupled to one closure member, and the other actuator is coupled to the other closure member. Claim 19 recites an air mass flow controller valve for fuel cells including first and second actuators being respectively coupled to first and second closure members. Support for these features is provided at, for example, paragraph 0010, of Applicant's originally filed specification.

In contrast, as described at col. 2, ll. 3-8, de Versterre shows a unitary valve-positioning actuator module having a mounting face adapted for removable assembly in register to the mounting face of a valve-body module having a valve stem exposed. Accordingly, as shown in Fig. 2, and described at col. 3, ll. 41-45, the reduced upper end of the stem 31 of the valve member 32 projects upward, above the plane of surface 18, for coaction with module 10. As shown in Fig. 4, and described at col. 4, ll. 33-44, actuator module 10 is fully self-contained within housing 50, and includes bore 52 to accommodate electromagnetic drive components having registered abutment at 55 with the projecting end 31 of the valve stem when modules 10-11 are assembled. Thus in the instant invention the actuators are coupled to respective closure members, whereas de Versterre shows actuators merely abutting respective closure members. Accordingly, Applicant respectfully submits that de Versterre does not teach every element of claims 1 and 19.

Moreover, it is respectfully submitted that modifying the system of de Versterre to couple the electromagnetic drive components with the projecting end 31 of the valve stem would render de Versterre unsatisfactory for its intended purpose. As discussed at col. 1, ll. 55-58, it is a

specific object of de Versterre to provide an actuator module that is detachably related to a valve-body module that contains the valve member. As discussed in M.P.E.P. § 2143.01, “[i]f the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).” Accordingly, Applicant respectfully submits that claims 1 and 19 are patentable.

Claims 2 and 5-12 ultimately depend from claim 1, and recite the same combination of allowable features recited in claim 1, as well as additional features that further distinguish over the prior art. At least for the above-described reasons, Applicant respectfully requests that all rejections by de Versterre be withdrawn and the claims allowed.

CONCLUSION

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing all pending claims in condition for allowance. Applicant submits that the claim amendments do not raise new issues or necessitate additional search of the art by the Examiner.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite the prosecution.


If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Dated: October 24, 2003

By:



Peter J. Sistare

Registration No. 48,183

CUSTOMER NO. 009629

MORGAN, LEWIS & BOCKIUS LLP

1111 Pennsylvania Avenue, N.W.

Washington, D.C. 20004

202-739-3000